

REMARKS

This Response is submitted in response to the Office Action dated July 11, 2002. Claims 1, 2, 6, 7, 11, 12, 13, 14 and 15 have been amended. Claims 9 and 10 have been cancelled without prejudice or disclaimer. New Claims 16 to 48 have been added. No new matter has been added.

Applicant thanks the Examiner for granting the personal interview conducted on October 22, 2002 with the applicant's representatives. A Petition for a Two-Month Extension of Time to Respond to the Office Action is submitted herewith. A check in the amount of \$1,288.00 is submitted herewith to cover the cost of the two-month extension and the additional Claims. A Declaration by the inventor, Aaron Jones, under § 1.132 is submitted herewith.

The Abstract of the Disclosure was objected to as not being in the proper Abstract language and format. Applicant has amended the Abstract to contain less than 150 words, and to overcome the language and format objections.

The Office Action also indicates that the title of the invention is objected to as not being descriptive, and suggested the following title: "Slot Machine with Hyperlinked Paytable Information." Applicant respectfully disagrees with the objection. The claimed invention is only limited by the scope of the claims, and is not limited to slot machines with hyperlinked payable information. Accordingly, Applicant has not amended the title because such a title would be inappropriate.

Claims 7, 9, and 10 were also objected to under 37 C.F.R. 1.75(c) as being in improper dependent form for failing to further limit the subject matter of a previous claim. Claim 7 has been amended to overcome this rejection and not for the purpose of distinguishing over the prior art. Claims 9 and 10 have been cancelled without prejudice or disclaimer.

New Claims 13 to 15 were further objected to because the language in these claims did not match language of Claim 11 from which they depend. Claims 13 to 15, as well as Claim 12, have been amended to match the language of Claim 11 to overcome this rejection and not for the purposes of distinguishing over the prior art.

Claims 2 and 11 have been amended for clarity and not for the purpose of distinguishing over the prior art. Specifically, Claim 2 has been amended to clarify that the reels are controlled by the controller, and Claim 11 has been amended to clarify that the reels are controlled by the controller and that the payable associated with the selected symbol is displayed when the player selects that symbol.

Claims 6, 7, 9, and 10 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action asserts that no antecedent basis for "said displays" exists in claims 6 and 9. Claims 9 and 10 have been cancelled. Claims 6 and 7 have been amended to overcome this rejection and not for the purposes of distinguishing over the prior art.

Claim 14 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action indicated no antecedent basis existed for "said displays." The Office Action also asserts the word "togglng" to be inapt. Claim 14 has been amended to overcome this rejection and not for the purposes of distinguishing over the prior art.

The Office Action rejected Claims 1 to 15 under 35 U.S.C. § 103(a) as being unpatentable over Heidel in view of Lemay and Fey. In particular, the Office Action rejected Claims 1, 3, 4, 7, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Heidel et al. in view of Lemay and Fey. Applicant respectfully disagrees with this rejection of Claims 1 to 15 and traverses based on the following reasons.

The Office Action asserts that Heidel teaches a game controller, a display device attached to the controller, at least one reel displayed on the display device, at least one symbol displayed on the reel, and a touch screen connected to the controller for selecting a symbol. The Office Action further asserts that Heidel discloses "a payable display for the symbol stored in memory" and that "Heidel teaches displaying the payable when the player pushes the payable area of the screen, not when the player selects a symbol." Contrary to the assertions of the Office Action, Heidel expressly states that the display device displays: "a payable 18 that provides the player with the values for various winning combinations of cards." (Col. 2, lines 24-29). Thus, contrary to the asserted conclusion, Heidel does not disclose touching a payable area on the

screen to display a payable. It is however, recognized as discussed during the interview that "Paytable," "See Pays," and "Help" buttons or inputs which when activated cause the display device to reveal the entire payable for all of the symbols were known in the art prior to the present invention. These buttons were separate or spaced from the game reels and symbols or game cards.

In contrast, Claim 1, which has been amended for clarity purposes, is directed to the selection of a symbol on a reel that causes the display of the payable associated with that selected symbol. Heidel and the recognized prior art clearly do not disclose, teach or suggest the selection of a symbol on a reel which causes the display of the payable or part of the payable associated with that selected symbol.

To supply the elements of Claim 1 stated as missing from Heidel, the Office Action relies on Lemay and Fey. With respect to Lemay and Fey, the Office Action explains that "Fey teaches the traditional appearance of the payable" and Lemay teaches "[h]yperlinked, context sensitive help is well known in the art." The Office Action concludes that there is a motivation for combining Lemay and Heidel because the hyperlinks of Lemay make gaining payable information quicker. As discussed in further detail below, it is respectfully submitted that the only way to reach this conclusion is by the use of impermissible hindsight because there is no motivation or suggestion in these references to combine hyperlinking with an entire payable request input and then to change that input to be a symbol and the portion of the payable displayed to be the part of the payable for that symbol.

More specifically, contrary to the asserted conclusion, the continuously displayed payable of Heidel provides necessarily quicker payable information than combining Heidel with Lemay's hyperlinks to access and display such information. Heidel's payable is continuously displayed and combining Heidel and Lemay would add unnecessary steps to display the payable. Thus, the Office Action's suggested quickness motivation for combining Heidel and Lemay's hyperlinks to display payable information is incorrect. The Office Action has thus failed to present a *prima facie* case of obviousness because the cited combination of references does not teach or suggest all of the elements of Claim 1. A *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

Moreover, Applicant submits that the article by Lemay is non-analogous art. Specifically, Lemay relates to web publishing using hypertext mark-up language (HTML), which is far afield from gaming devices. Furthermore, the Lemay reference is not reasonably pertinent to the particular problem with which the applicant was concerned. As stated in *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 U.S.P.Q. 2d 1767 (Fed. Cir. 1993) “[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor(s) endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” In the present application, Applicant respectfully submits that Lemay is not a teaching that logically would have commended itself to an inventor’s attention in considering the problem of complicated paytables (as described in the attached Declaration of Aaron Jones) and displaying a payable for a symbol in a clear, easy and immediately obtainable manner. Lemay deals with web HTML programming for publishing information on the internet and one in the art of gaming devices would not necessarily look to internet technology to solve the problem of displaying complicated paytables in the gaming field.

Lemay is also not reasonably pertinent to the particular problem solved by the present claimed invention, namely narrowing the displayed payable or other information from the larger exhaustive payable. That is, narrowing the scope of displayed information pertinent to a particular symbol. In contrast, the particular teaching of Lemay relied upon in the present office action deals with broadening the scope of displayable information beyond a particular page such that storage space can be minimized (see Lemay, page 11, lines 1-4). Thus, the teachings of Lemay are further not reasonably pertinent to problems addressed by the claimed invention.

In light of the foregoing, the Applicant respectfully submits that reliance on the teachings of Lemay under 35 U.S.C. § 103 is improper due to the non-analogous nature of the teachings and runs afoul of the mandates of MPEP § 2141.01(a).

Additionally, Applicant submits that a motivation or suggestion to combine the cited references is lacking. In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (see MPEP Section 2143.01). As the Federal Circuit has opined, “there are three possible sources for a

motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Office Action has not established motivation from any of these three sources.

With respect to the first source of motivation, the nature of the problem to be solved would not direct one of ordinary skill in the art to look to HTML technology for a solution as discussed above regarding the non-analogous nature of Lemay.

Regarding the second source of motivation, the prior art of record is absent of any teachings, either explicit or implicit, to combine the cited references to arrive at the presently claimed invention. That is, Heidel merely teaches the display of a payable for various winning card combinations. Heidel is devoid of any teaching or suggestion to display a payable of a particular card (i.e., or symbol). Fey does not provide any teaching or suggestion for this feature and Lemay contains absolutely no teaching or suggestion even pertaining to gaming devices and, more particularly, to displaying a portion of a payable associated with a selected symbol. Thus, the prior art presented in the Office Action provides no motivation to combine the references to arrive at the present claims.

Since the first two possible sources clearly do not provided a motivation to combine the cited references, the Office Action appears to have relied upon final motivation to combine which is knowledge of persons of ordinary skill in the art. The Office Action reasons as follows:

[Providing hyperlinks] makes it faster and easier for a user to gain information. The less time spent searching paytables, the more time spent gambling. This leads to greater profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have displayed payable information about a particular symbol when it was chosen by a player via a hyperlink in order to quickly provide information to the player so that the player doesn't have to spend time searching the paytables and can spend more time gambling – thus increasing casino profits. (Page 5, lines 5-11 of the present office action).

This motivation in the Office Action is essentially an efficiency/profit rationale to increase gambling time of players and, thus, casino profits. However, this rationale is possibly present in many advances in the gaming device art, as well as many other art areas.

This generic motivation likely drives development of scores of technological advances and such generic motivation to combine references could be used to reject many advances in this art area and many other arts. Therefore, it is respectfully submitted that this motivation does not lead to the combination of the references in the manner cited by the Office Action.

More importantly, this alleged motivation, even if proper, still would not specifically motivate one of ordinary skill in the art at the time of invention to specifically modify a video slot machine to enable selecting a specific symbol on a reel to display a payable or the part of a payable for that specifically selected symbol as featured in the present claims. The rationale provided by the Office Action is insufficient to show why one of ordinary skill in the art would be specifically motivated to make the claimed invention over other apparatus and methods to achieve the end benefit. For instance, video slot machines known in the art at the time of the invention employed player assistance or help screens activated by touch screen selection of a "Paytable," "See Pays," or "Help" input displayed on the screen other than at the location of the specific symbols on the reels (i.e., at a location separate or distinct from the game reels). Using this knowledge, it is possible that one of ordinary skill would include either further inputs separate or distinct from the reels to provide more specific payable information. However, this is not the present invention which is rather directed to player selection of a specific symbol to obtain the payable or part of the payable associated with that specific selected symbol. Moreover, the addition of a hyperlink to a video slot machine having "Paytable," "See Pays" or "Help" input simply results in a slot machine providing the currently known features payable information using hyperlinks. The combination does not suggest providing a new feature wherein the selection of a specific symbol on a reel, such as the touch of touch screen in the area of a displayed reel symbol causes payable information for that specific selected symbol to be displayed to the player. The Office Action has not shown how one of ordinary skill in the art would be motivated to depart from the conventional knowledge in the art to reach this invention. Thus, it appears that the rationale of the Office Action instead relies on impermissible hindsight gleaned from the applicant's disclosure to provide the missing motivation in order to arrive at the claimed invention.

It is well settled law that obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed invention. *ATD Corp v. Lydall, Inc.*, 48 U.S.P.Q. 2d 1321, 1329 (Fed. Cir. 1998). The Federal Circuit has clearly iterated that:

[v]irtually all inventions are necessarily combinations of old elements. The notation, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate Prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103.

Panduit Corporation v. Dennison Manufacturing Co., 810 F.2d 1561, 1575 (Fed. Cir. 1987). Moreover, the Federal Circuit has specifically cautioned against from doing exactly what the Office Action in the present application has done:

[a]s this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

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. . . To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

Yamanouchi Pharmaceutical Co., Ltd., et al v. Danbury Pharmacal, Inc., et al., 231 F.3d 1339, 1343 (Fed. Cir. 2000) (Rehearing and Rehearing In Banc Denied, December 14, 2000).

When the Patent Office fails to explain how the skilled artisan would have been motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been impermissibly made in hindsight. *In re Rouffet*, supra, (citing *In re Gorman*, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991)). Additionally, the MPEP mandates that impermissible hindsight must be avoided and the legal conclusion of obviousness must be reached on the basis of the facts gleaned from the prior art (See MPEP §2141.03). Although, as stated in case law often relied on by the

U.S. Patent Office (See paragraph A of subsection X of Section 2145 of the MPEP), that “[a]ny judgment of obviousness is in a sense necessarily a reconstruction based on hindsight reasoning” *In re MacLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971), this nonetheless does not relieve the Patent Office of ensuring that the obviousness determination takes into account only knowledge which was with the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned from the applicant’s disclosure. The asserted rejections in the present Office Action do not properly take only knowledge in the art into account since the determination did not take only the knowledge in the art into account, but additionally lifted motivation from the applicant’s disclosure (i.e., to apply hyperlinks to the specific symbols on a reel and not just to the existing entire payable request inputs).

Furthermore, Applicant submits concurrently herewith a declaration under 37 C.F.R. § 1.132 indicating that the invention of the claims satisfies a twenty-five year old long-felt need that was not solved by others. During this time period, the problem of complicated paytables existed in both mechanical and video slot machines. The present invention solves this problem. Applicant submits that this objective evidence of the secondary consideration of long-felt need is relevant to the issue of obviousness and must be considered (see MPEP § 2141 and § 716.01(a)). In light of the foregoing objective evidence, Applicant submits that the claims are further not obvious in light of the prior art of record.

The declaration under 37 C.F.R. § 1.132 also presents strong evidence that the invention of the claims is being copied by a competitor in the gaming device marketplace. Applicant submits that this objective evidence of the secondary consideration of copying is relevant to the issue of obviousness and must be considered (see MPEP § 716.01(a), 716.06 and 2141). Furthermore, the MPEP provides that such factors must be considered (see MPEP § 716.04). In light of the foregoing objective evidence of copying by a competitor, Applicant submits that the claims are further not obvious in light of the prior art of record and are in condition for allowance.

Amended Claim 11 is an independent method claim for providing payable information for a gaming device comprising the steps of displaying at least one symbol

on at least one reel connected to a controller of said gaming device, enabling a player to select said symbol, and displaying at least one payable associated with said selected symbol display. Like Claim 1, the Office Action rejected Claim 11 as obvious in view of Heidel, Lemay, and Fey. For the above reasons, the Office Action, therefore, has also failed to establish a *prima facie* case of obviousness of amended independent method Claim 11. Claims 2 to 8, which depend from amended Claim 1, including amended Claims 6 and 7, and amended Claims 12 to 15, which depend from amended Claim 11, are also not obvious. *In re Fine*, 837 F.2d at 1076 ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious").

In light of the foregoing comments, Applicant requests reconsideration of the rejections of Claims 1 to 8 and 11 to 15 and submits that these claims are allowable over Heidel, Lemay and Fey.

Furthermore, Applicant has submitted newly added Claims 16 to 48. These claims are patentably distinguished over Heidel, Lemay and Fey for the reasons stated above. Additionally, in new Claim 44, the gaming device causes a random generation of a plurality of the symbols, causes the display device to display the randomly generated symbols and upon player selection of one of the randomly generated symbols, causes the display device to display a part of the payable associated with that symbol. Similarly, new Claim 46 which is directed to a method of operating a gaming device, includes randomly generated symbols on the reels from the plurality of symbols, enabling a player to select one of the randomly generated symbols, and displaying a part of payable associated with one of the randomly generated symbols upon the player selection of said randomly generated symbol. The combination of Heidel, Lemay and Fey does not allow for the selection of a randomly generated symbols and the display of the payable associated with a selected randomly generated symbol. The hyperlinks of Lemay are associated with fix text or graphics, not randomly generated symbols. Accordingly, it is respectfully submitted that Claims 1 to 8 and 11 to 48 are in condition for allowance.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current response. The attached page is captioned **"Version with Markings to Show Changes Made."**

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, applicant respectfully requests that the Examiner contact the applicant's attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Respectfully submitted,

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Version With Markings to Show Changes Made

In the Specification:

The Abstract of the Disclosure has been amended as follows:

The present invention includes an apparatus and method for quickly and easily providing desired payable information to a player of a gaming device. The invention utilizes the game's display device containing a plurality of game generated symbols as an index of symbols from which a player can choose a desired symbol. The present invention enables a player to touch or otherwise select the desired symbol and produce desired payable information, which includes a plurality of different types of information. ~~Touching a desired symbol is simple, interactive and entertaining. Such features are not inherent in the existing methods.~~ The invention contemplates the game maintaining one or more databases for every single symbol. Alternatively, the game can maintain one or more databases having information on all the symbols of the gaming device and immediately scroll to the desired symbol upon the player's selection.

In the Claims:

Claim 1 has been amended as follows:

1. (Amended) A gaming device comprising:
a controller;
a display device connected to said controller;
at least one reel displayed by said display device;
at least one symbol displayed on said reel;
means connected to the controller for selecting one of said symbols; and
at least one payable display for said selected symbol stored in said controller;
whereby selecting said symbol causes said controller to cause said display device to display a payable display for said selected symbol.

Claim 2 has been amended as follows:

2. (Amended) The gaming device of Claim 1, which includes a plurality of reels controlled by~~connected to~~ said controller and a plurality of symbols displayed on at the plurality of reels.

Claim 6 has been amended as follows:

6. (Amended) The gaming device of Claim 5, wherein said at least one payable display includes a plurality of displays, and wherein each of a said plurality of said displays contains different payable information from each of the other of said plurality of displays.

Claim 7 has been amended as follows:

7. (Amended) The gaming device of Claim 6, which includes means for selecting one of said ~~at least one payable~~ plurality of displays.

Claim 9 has been cancelled without prejudice or disclaimer.

Claim 10 has been cancelled without prejudice or disclaimer.

Claim 11 has been amended as follows:

11. (Amended) A method of providing payable information for a gaming device comprising the steps of:

- (a) displaying at least one symbol on at least one reel controlled by~~connected to~~ a controller of said gaming device;
- (b) enabling a player to select said symbol; and
- (c) displaying at least one payable associated with said selected symbol ~~when the player selects said symbol display~~.

Claim 12 has been amended as follows:

12. (Amended) The method of Claim 11, wherein displaying a at least one payable display includes ~~the step of scrolling through a display to an area~~ displaying a portion of the payable for said selected symbol.

Claim 13 has been amended as follows:

13. (Amended) The method of Claim 11, wherein displaying ~~a plurality of~~ at least one payable displays includes a plurality of paytables, and the step of sequencing said displays paytables according to a sequence contained in said controller.

Claim 14 has been amended as follows:

14. (Amended) The method of Claim 11, wherein displaying ~~a plurality of~~ at least one payable displays includes displaying a plurality of paytables for a plurality of symbols. ~~the step of enabling said player to select a means for sequentially toggling through said displays.~~

Claim 15 has been amended as follows:

15. (Amended) The method of Claim 11, wherein displaying a plurality of at least one payable displays includes the step of enabling said player to select one of a plurality of means for selecting a single display paytable.

Claims 16 to 48 have been added.



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